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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,751	07/31/2003	Kenji Shimizu	Q71391	9957

7590 10-01/2004
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EXAMINER

RICKMAN, HOLLY C

ART UNIT PAPER NUMBER

1773

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/630,751	Applicant(s) SHIMIZU ET AL.	
	Examiner Holly Rickman	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12102003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "softly magnetic" in claims 1 and 9-10 is a relative term which renders the claims indefinite. The term "softly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "soft magnetic" is an art recognized term. It is not clear if the metes and bounds of "softly" magnetic and "soft magnetic" are the same.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1773

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomiyasu et al. (US 6670055) in view of Chang et al. (US 6777066).

Tomiyasu et al. disclose a magnetic recording medium having a substrate, a pre-coat layer, multiple underlayers, a CoPt-alloy magnetic layer and a protective overcoat. The reference teaches that the precoat layer is formed from an alloy containing Cr and another element such as C in an amount up to 10 at%. This precoat layer corresponds to the claimed "orientation control layer" because it necessarily controls the orientation of the layer that is epitaxially grown thereon. The reference teaches that the recording medium can be perpendicular. See Figure 1; col. 3, line 60 to col. 4, line 8; col. 5, lines 13-15; col. 6, lines 28-36 and lines 49-50.

Tomiyasu et al. is silent with respect to the claimed "softly magnetic under-film" (which has been interpreted to mean a soft magnetic layer) and the use of a monopole head.

Chang et al. teach the it is well known in the art to use a soft magnetic underlayer disposed on a substrate in a perpendicular magnetic recording medium for the purpose of guiding magnetic flux emanating from the magnetic head (col. 1, lines 35-51). The reference also teaches that it is well known in the art that single-pole magnetic heads allow for high linear recording densities to be achieved when used with perpendicular recording media (col. 1, lines 32-34).

It would have been obvious to one of ordinary skill in the art at the time of invention to add a soft magnetic layer on top of the substrate taught by Tomiyasu et al. in order to improve thermal stability of the medium by guiding stray flux emanating from the magnetic head as suggested by Chang et al. Furthermore, it would have been obvious to use a single-pole

Art Unit: 1773

magnetic head in conjunction with the recording medium taught by Tomiyasu et al. in order to achieve high linear recording density.

With respect to the limitation of claim 3 requiring the presence of 30-70 at % C in the CrC layer, it is the Examiner's contention that it would have been obvious to optimize the amount of C added to the CrC containing layer taught by Tomiyasu et al. Tomiyasu et al. teach that the addition of C to the Cr layer produces a fine crystal grain size and narrow grain size distribution. Thus, it would have been obvious to adjust the amount of C added to obtain the optimal benefit. Such as optimization would have been obvious since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman
Primary Examiner
Art Unit 1773

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September 29, 2004